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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225401
Party	Defendant Gordon McKernan Injury Attorneys, Limited Liability Companyd Liability Com- pany
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Whitehardt, Inc.,**

Opposer

vs.

**Gordon McKernan Injury Attorneys,  
LLC**

Applicant

**Opposition No.:** 91225401

**In the Matter of Application Ser.  
No.:** 86/568,706

**For the Mark:**



**Filing Date:** March 18, 2015

**ANSWER & AFFIRMATIVE DEFENSES**

In answering the Notice of Opposition of Opposer Whitehardt, Inc. (“Whitehardt” or “Opposer”), Gordon McKernan Injury Attorneys, LLC (“The McKernan Law Firm” or “Applicant”), through undersigned counsel, denies each and every allegation contained in the enumerated paragraphs in the Notice of Opposition except those which may hereafter be affirmatively, expressly and unequivocally admitted and further avers and pleads as follows:

Applicant denies the allegations in the first unnumbered paragraph for lack of information sufficient to justify a belief therein, except to the extent they call for a legal conclusion as to which no response is required, and further except to the extent Applicant admits that it filed Application Serial No. 86/568,706 filed by Applicant for the design mark of a “stylized line drawing of a man standing on the hood of a semi-truck” covering “[l]egal services” in International Class 45.

1. Applicant admits the allegations in ¶ 1.

2. Applicant denies the allegations of ¶ 2 for lack of information sufficient to justify a belief therein, except to admit that Opposer is an advertising agency and has created advertising for law firms.
3. Applicant denies the allegations in ¶ 3 for lack of information sufficient to justify a belief therein.
4. Applicant denies the allegations in ¶ 4 for lack of information sufficient to justify a belief therein.
5. Applicant denies the allegations of ¶ 5 for lack of information sufficient to justify a belief therein, except to admit that Opposer is an advertising agency and has created advertising for law firms that reside in various states.
6. Applicant denies the allegations of ¶ 6, except to admit that Opposer is listed as the owner of U.S. Trademark Reg. Nos. 4,193,711; 3,886,100; 3,471,956, and 3,538,353, and to admit that the Certificates of Registration for the foregoing registrations are the best evidence of their contents.
7. Applicant denies the allegations in ¶ 7 for lack of information sufficient to justify a belief therein.
8. Applicant denies the allegations in ¶ 8 for lack of information sufficient to justify a belief therein.
9. Applicant denies the allegations in ¶ 9 for lack of information sufficient to justify a belief therein, except to admit that Opposer is listed as the owner of U.S. Trademark Appl. No. 86/633,231 for the design mark of a “a man standing on a semi-tractor trailer” covering “[l]egal services” in International Class 45, and to admit that the USPTO record for the foregoing application is the best evidence of its contents.

10. Applicant denies the allegations in ¶ 10.
11. Applicant admits the allegations in ¶ 11.
12. Applicant denies the allegations in ¶ 12, except to admit that the Examiner in Opposer's '231 Application cited Applicant's '706 Application as *one* ground for refusal for Opposer's '231 Application, with other grounds for refusal including, without limitation, the fact that Opposer's use of the mark in the '231 Application does not function as a service mark for the Opposer's services. Applicant further admits that the USPTO record for the '231 Application is the best evidence of its contents.
13. Applicant denies the allegations in ¶ 13, except to admit that the alleged first date of use of the mark in Opposer's '231 Application pre-dates Applicant's '706 Application filing date of March 18, 2015.
14. Applicant denies the allegations in ¶ 14, except to admit that the Examiner in Opposer's '231 Application cited Applicant's '706 Application as *one* ground for refusal for Opposer's '231 Application, and to admit that the USPTO record for the '231 Application is the best evidence of its contents.
15. Applicant denies the allegations in ¶ 15, except to admit that the USPTO record for Opposer's '231 Application and Applicant's '706 Application are the best evidence of their contents.
16. Applicant admits the allegations in ¶ 16.
17. Applicant denies the allegations in ¶ 17 for lack of information sufficient to justify a belief therein.
18. Applicant denies the allegations in ¶ 18 for lack of information sufficient to justify a belief therein.

19. Applicant denies the allegations in ¶ 19.
20. Applicant admits the allegations in ¶ 20.
21. Applicant denies the allegations in ¶ 21 for lack of information sufficient to justify a belief therein.
22. Applicant denies the allegations in ¶ 22.
23. Applicant denies the allegations in ¶ 23.
24. Applicant denies the allegations in ¶ 24.
25. Applicant denies the allegations in ¶ 25.
26. Applicant denies the allegations in ¶ 26.
27. Applicant denies the allegations in ¶ 27.
28. Applicant denies the allegations in ¶ 28.
29. Applicant denies the allegations in ¶ 29, except to admit that the Examiner in Opposer's '231 Application cited Applicant's Registrations as one of several grounds for refusal for Opposer's '231 Application, with other grounds for refusal including, without limitation, the fact that Opposer's use of the mark in the '231 Application does not function as a service mark for Opposer's services. Applicant further admits that the USPTO record for the '231 Application is the best evidence of its contents.
30. Applicant admits the allegations in ¶ 30.
31. Applicant denies the allegations in ¶ 31, except to admit that Opposer seeks cancellation of Applicant's Registrations (Reg. Nos. 4,681,608 and 4,525,497) in the Federal Case pending in the Middle District of Tennessee, but Applicant denies that Opposer is entitled to such relief in the Federal Case.
32. To the extent a response is required, Applicant denies the allegations in ¶ 32.

## **RESPONSE TO OPPOSER'S PRAYER FOR RELIEF**

A response is not required to Opposer's Prayer for Relief. To the extent that a response is deemed required, Applicant denies that Opposer is entitled to any relief whatsoever.

### **AFFIRMATIVE DEFENSES**

#### **FIRST AFFIRMATIVE DEFENSE:**

Applicant owns a prior registration—U.S. Reg. No. 4,525,497 (the '497 Registration)—for essentially the same mark registered in connection with essentially the same services that are the subject of Applicant's opposed '706 Application, and the '497 Registration (and Applicant's use of the mark which is the subject of the '497 Registration) predates any legitimate use of the design mark in the '231 Application by Opposer.

#### **SECOND AFFIRMATIVE DEFENSE:**

Whitehardt lacks standing, as Whitehardt does not have valid trademark rights in the design mark which is the subject of U.S. Trademark Appl. No. 86/633,231 for legal services under any federal or state law since an advertising agency, as a matter of law, cannot use a trademark in conjunction with the offering of legal services and cannot develop or retain goodwill in a trademark for legal services.

THIRD AFFIRMATIVE DEFENSE:

Whitehardt lacks standing, as Whitehardt does not have valid trademark rights in the design mark which is the subject of U.S. Trademark Appl. No. 86/633,231 for legal services under any federal or state law since Opposer abandoned the trademarks, if any, by engaging in naked licensing.

FOURTH AFFIRMATIVE DEFENSE:

Whitehardt lacks standing, as Whitehardt does not have valid trademark rights in the design mark which is the subject of U.S. Trademark Appl. No. 86/633,231 for legal services under any federal or state law since Whitehardt's use of the trademarks through third parties, if any, fails to comply with the statutory requirements set forth in 15 U.S.C. § 1055.

FIFTH AFFIRMATIVE DEFENSE:

Whitehardt lacks standing, as Whitehardt has committed fraud on the USPTO in the filing of U.S. Trademark Appl. No. 86/633,231 (Opposer's '231 Application) for "legal services"— services that "unauthorized practice of law" statutes prohibit Whitehardt from offering. Whitehardt, through its legal representatives, has also presented a false date of first use. Whitehardt, therefore, will not be damaged by the registration of Applicant's '706 Application.

Whitehardt is an advertising agency which produces television commercials and other advertisements for law firms. Neither Whitehardt's principals nor its employees are licensed or authorized to practice law.

Beginning in 2008, Whitehardt started producing commercials for The McKernan Law Firm focusing on 18-wheeler accidents. The initial commercial featured Mr. Gordon McKernan—a principal of The McKernan Law Firm—standing next to an 18-wheeler truck.

Mr. McKernan subsequently suggested to Whitehardt that the next 18-wheeler truck commercial should feature Mr. McKernan standing on the trailer of the 18-wheeler truck. The first “Lawyer on the Trailer” commercial aired on or about April 5, 2010. Initially, Whitehardt was not producing “Lawyer on the Trailer” commercials for any other law firm. After noting the successful results obtained from the commercials, and upon receiving permission from Mr. McKernan, Whitehardt began producing “Lawyer on the Trailer” commercials for other attorneys in states outside of Louisiana and Mississippi.

The McKernan Law Firm has been active in legally protecting its brands, including through applications for federal trademark registration with the United States Patent and Trademark Office. The McKernan Law Firm’s trademark portfolio includes: *Get Gordon!*<sup>®</sup> (2010); *Who’s Your Lawyer?*<sup>®</sup> (2010); *Stand Up to Big Trucks*<sup>®</sup> (2012); *Anytime Lawyer*<sup>®</sup> (2012) and others. The McKernan Law Firm’s branding is also reflected in the TV commercials produced by Whitehardt, as the public naturally came to recognize both the slogans and imagery contained in the commercials as a source identifier, *i.e.*, a trademark.

To further strengthen Mr. McKernan’s image as the “lawyer on the truck,” The McKernan Law Firm developed a billboard advertising campaign in 2011 using the Lamar Advertising Agency. The campaign is constructed around a billboard that shows Mr. McKernan standing on the hood of an 18-wheeler truck with his arms crossed.

As a result of the ubiquity of the “Lawyer on the Trailer” commercials on TV stations in the Louisiana and Mississippi markets and the ubiquity of Lamar billboards featuring Mr. McKernan standing on 18-wheeler trucks, Mr. McKernan has become known by the consuming public as the “lawyer on the truck.” In early 2013, The McKernan Law Firm applied for federal registration of the billboard imagery, namely an attorney standing on the hood of an 18-wheeler



truck (the '497 Billboard Mark). In June 2014, The McKernan Law Firm also applied for registration of his TV commercial imagery, namely an attorney standing on the trailer of an 18-wheeler truck (the '608 Trailer Mark). The '497 Billboard Mark and the '608 Trailer Mark are reproduced below:



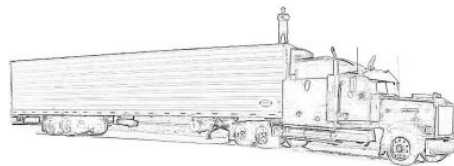
'497 Billboard Mark  
(U.S. Reg. No. 4,525,497)



'608 Trailer Mark  
(U.S. Reg. No. 4,681,608)

Both the '497 Billboard Mark and the '608 Trailer Mark issued as registered trademarks in 2014 covering “legal services.”

In Whitehardt’s '231 Application, Whitehardt asserts that the following design mark was first used on April 5, 2010 in conjunction with the offering of “legal services”:



Notably, this April 5, 2010 first-use date is the same date that The McKernan Law Firm’s first “Lawyer on the Trailer” commercial aired. While this TV commercial was produced by Whitehardt, the consumer goodwill associated with the “Lawyer on the Trailer” image inured to the benefit of The McKernan Law Firm—the entity whom the consuming public recognizes as the source of the legal services being advertised. Similarly, through the display of billboards featuring Mr. McKernan standing on 18-wheeler trucks, the consumer goodwill associated with the

depicted image inured to the benefit of The McKernan Law Firm—the entity whom the consuming public recognize as the source of the legal services being advertised. Thus, through the public display of its commercials and billboards, The McKernan Law Firm acquired valuable trademark rights in both the ‘497 Billboard Mark and ‘608 Trailer Mark.

When Whitehardt filed U.S. Trademark Appl. No. 86/633,231 on May 18, 2015, Whitehardt was aware of both The McKernan Law Firm’s use and registration of the ‘497 Billboard Mark and ‘608 Trailer Mark. Moreover, in a 2010 trademark infringement lawsuit between Whitehardt and a competitor advertising agency, Whitehardt had asserted to the district court that **“an advertising agency, as a matter of law, cannot develop or retain goodwill in a trademark for legal services.”** See *CJ Advertising, LLC. v. Whitehardt, et. al.*, Case 3:10-cv-00214 (M.D. Tenn. 2010)(Dkt. 54-Answer). Nevertheless, In filing the ‘231 Application, Opposer’ s attorney of record, Keaton H. Osborne, on May 15, 2015, executed the required declaration, including declaring that the signatory believes:

...that the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application.

Whitehardt, through its counsel, submitted this declaration despite being aware of: i) The McKernan Law Firm’s prior use of a both the ‘497 Billboard Mark and ‘608 Trailer Mark; ii) Whitehardt’s inability itself to use the applied-for mark in the offering of legal services; and iii) Whitehardt’s inability to use the trademark through licensee law firms pursuant to 15 U.S.C. 1055 since Whitehardt was prohibited from controlling the nature or quality of the legal services offered by its law firm clients. Accordingly, the declaration and first use date submitted with the ‘231

Application were material representations that were known to Whitehardt to be false. Nevertheless, they were submitted by Opposer with the intent to deceive the USPTO for purposes of procuring an illegitimate registration and/or provide grounds for initiating this opposition in bad faith. Opposer seeks the registration of the '231 Application, as well as the instant Opposition, with unclean hands.

SIXTH AFFIRMATIVE DEFENSE:

Opposer seeks the registration of the '231 Application, as well as the instant Opposition, with unclean hands.

SEVENTH AFFIRMATIVE DEFENSE:

The Opposer's claims are barred by the doctrine of laches.

EIGHTH AFFIRMATIVE DEFENSE:

The Opposer's claims are barred by estoppel.

Respectfully submitted,

/s/ Michael K. Leachman

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### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served on Whitehardt, Inc. through its counsel of record by sending said copy on February 24, 2016, via First Class Mail, postage prepaid and by e-mail to:

Phillip E. Walker  
BRADLEY ARANT BOLT CUMMINGS, LLP  
1600 Division Street, Suite 700  
Nashville, TN 37203.

**Date:** February 24, 2016

/s/ Michael K. Leachman

Michael K. Leachman